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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,983	11/07/2001	Keith D. Allen	R-517	9383

7590 02/11/2003
DELTAGEN, INC.
740 Bay Road
Redwood City, CA 94063

EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,983

Applicant(s)

ALLEN ET AL.

Examiner

Celine X Qian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-24 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 12 and 14-22, drawn to a PERK targeting vector, a method of making said vector, a PERK gene knockout animal, cells isolated from said animal, and a method of making said animal, classified in class 536, subclass 23.1, class 800, subclass 3, 18, 22, and class 435, subclass 325.
- II. Claim 11, drawn to a method of identifying an agent that regulates PERK expression by using a PERK knockout cell, class 536, subclass 24.1.
- III. Claims 11, drawn to a method of identifying an agent that regulates PERK function by using a PERK knockout cell, class 435, subclass 354.
- IV. Claim 13, drawn to an agent regulates the expression or function of PERK, unclassifiable.
- V. Claim 23, drawn to an agent that ameliorates a phenotype of the PERK knockout mouse, unclassifiable.
- VI. Claim 24, drawn to an agonist or an antagonist of PERK, class 530, subclass 300.

The inventions are distinct, each from the other for following reasons.

The inventions of Groups I and IV-VI are patentably distinct because the inventions are drawn to materially distinct compositions and methods that are not related. The compositions of Groups I and IV-VI are biologically, chemically, and functionally distinct from each other. The methods of Group I are not directly related compositions of Groups IV-VI. For example, the

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agents of Group IV can also be identified by using a wild type animal. Therefore, these inventions are patentably distinct from each other.

The inventions of Groups II and III are patentably distinct because the inventions are drawn to methods that require different starting materials and modes of operation. Each method comprises distinct steps. Therefore, the inventions of Groups II-V and VII are patentably distinct.

The compositions and methods of Groups I, IV-VI and Groups II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different function, and different effects each from the other. The products of Groups IV-VI can be used in methods that require different technical considerations and materially different reagents from the method of Groups II-V and VII. The method of Group II can be practiced with products that have different chemical structures than the products of Groups I, IV-VI. For example, the mouse of Group I can be used as a disease model while the cells can be used to isolate protein *in vitro*. The method of Group II can also be practiced with a wild type animal or cell; therefore, the agent of Group IV can also be produced by using the wild type animal or cell. Therefore, the inventions of Groups I, IV-VI and Groups II and III are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, different classifications, and separate search requirement, restriction for examination purposes as indicated

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is proper. A search of the subject matter of one invention would not be co-extensive with a search of the other invention, and therefore the search would be burdensome. Each invention is capable of supporting a separate patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.
February 10, 2003

Anne-Marie Falk
ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER